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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,851	06/18/2001	Bogdan C. Maglich	HIENER.1CPC1CP	9955
20995	7590	05/28/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			KEITH, JACK W	
			ART UNIT	PAPER NUMBER
			3641	

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/883,851	MAGLICH, BOGDAN C.
	Examiner	Art Unit
	Jack W. Keith	3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 February 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/17/2004.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Request for Continued Examination***

1. The request filed on 2/12/2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/883,851 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Election/Restrictions***

2. With respect to the restriction/election of Paper no. 9 and applicant's election (dated 4/11/2003) of invention I, Species A (figure 1-3) it is noted that applicant's figure 18 is not directed to the elected species of figures 1-3. Particularly in comparing figures 1 and 18 one can clearly see the distance  $L_1$  of figure 1 wherein the distance from the target to the material examined is greater than the distance of the target to the alpha detector (distance  $L_2$ ). Figure 18 is the opposite distance  $L_1$  of figure 18 represents the distance from the target to the alpha detector this distance being greater than the distance of the target to the material examined (distance  $L_2$ ).

Unfortunately, the examiner (in the interview of 1/14/2004) agreed to allow figure 18 to read on the elected species. However, this, as set forth above, is clearly not the case. Common practice in RCE rules is there is no changing of inventions during prosecution. Proper recourse would have been to file a divisional application. Since the examiner and applicant have agreed to figure 18 as being the elected embodiment the action below reflects figure 18 only. Future arguments to figures 1-3 will be considered

as being directed to a non-elected embodiment. That is applicant cannot switch inventions again.

***Response to Arguments***

3. Applicant's arguments filed 2/12/2004 have been fully considered.

With regard to the nonstatutory double patenting rejection of claims 1-17 as being not obvious as previously set forth in paper no. 17 claims 1-17 although not identical are not patentably distinct from claims 1, 7 and 9-18 of co-pending Application No. 09/788,736 because each of the independent claim sets forth a particle generator, first and second subatomic particles, photon and alpha detectors and analyzers.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

With regard to the outstanding art rejection of Sawa the elected embodiment of figure 18 and the claims define over the prior art (Sawa).

***Specification***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description of the invention and as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

Referring to the specification pages 23-25 and figure 18 applicant states that a image magnification effect can be realized by increasing the distance of the detector arm  $L_1$  (target to alpha detector) in comparison to that of object arm  $L_2$  (target to material analyzed).

From the specification there is no indication of how and in what manner said image magnification is realized. For example no parameters are given as to the minimum and maximum values necessary to achieve the desired image magnification. Hypothetically, setting the detector arm  $L_1$  distance to infinity would appear to provide applicant with his maximum image magnification; however, the solid subtended angle of the alpha detector array would be so small that no counts would be registered. Thus, no image magnification would be present. The same is true for the minimum. The prior art (Sawa, Rhodes, etc.) set forth systems wherein the detector arm  $L_1$  distance appears to be equal or less than that of the object arm  $L_2$ . Thus the desired image magnification would not be achieved.

Clearly, without these parameters undue experimentation is warranted on the skilled artisan as such parameters are not set forth in applicant's disclosure.

Furthermore it would appear that the material analyzed also plays a key role in the desired image magnification. No such mention of which is present in the original disclosure.

There is no adequate description nor enabling disclosure of the parameters of a specific operative embodiments of the invention, including: the minimum and maximum solid angles required to achieve the desired image magnification, minimum and maximum distances required to achieve the desired image magnification, modifications necessary for different material analyzed, etc.

As set forth above, the examiner has presented evidence showing that applicant has not progressed his system beyond the point of an unproven theory or concept which still requires an undue amount of experimentation to enable the artisan to make and use the inventive system for its indicated purpose. This view is also considered supported by the failure to set forth a full example of the specific parameters of an operative embodiment. One cannot rely on the skill in the art for the selection of the proper quantitative values, since those in the art do not know what these values would be. See Bank v. Rauland Corp., 64 U.S.P.Q. 93; In re Corneil et al, 145 U.S.P.Q. 697.

Again, there is no evidence to indicate applicant has so succeeded in arriving at an operative system that produces improved image magnification, i.e., that he has progressed his system beyond the point of an unproven theory or concept which still requires an undue amount of experimentation to enable the artisan to make and use the invention for its indicated purpose.

It is thus considered that the examiner (for the reasons set forth above) has set forth a reasonable and sufficient basis for challenging the adequacy of the disclosure. The statute requires the applicant itself to inform, not to direct others to find out for themselves; In re Gardner et al, 166 U.S.P.Q. 138, In re Scarbrough, 182 U.S.P.Q. 298. Note that the disclosure must enable a person skilled in the art to practice the invention without having to design structure not shown to be readily available in the art; In re Hirsch, 131 U.S.P.Q. 198.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The reasons that the inventions as disclosed are not enabling are the same as the reasons set forth in section 5 above as to why the specification is objected to and the reasons set forth in section 5 above are accordingly incorporated herein.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Keith whose telephone number is (703) 306-

5752. The examiner can normally be reached on Monday-Thursday 6:30-5 p.m., with Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W. Keith  
Primary Examiner  
Art Unit 3641

jwk  
May 25, 2004